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H MERCK1617

EXAMINER

BERNHARDT, E

JA

ART UNIT

PAPER NUMBER

1202

DATE MAILED:

03/28/95

12M2/U328
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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-22 are pending in the application.

Of the above, claims 13, 19-22 are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-12, 14-15, 17-18 are rejected.

5. ☒ Claims 16 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit 1202

Restriction to one of the following inventions is required under 35

U.S.C. § 121:

I. Claims 1-12, 14-18, drawn to compounds and compositions where $Z=N$, classified in Class 544, subclass 373; Class 514, subclass 254.

II. Claims 1-11, 13, 17-18, drawn to compounds and compositions where $Z=CR^3$, classified in Class 546, subclass 201; class 514, subclass 323.

III. Claims 19-22, drawn to multi-methods of use employing group I compounds, classified in Class 514, subclass 254.

IV. Claims 19-22, drawn to multi-methods of use employing group II compounds, classified in Class 514, subclass 323.

If III or IV is elected applicants must further elect a use or related uses associated with a particular physiological activity.

The inventions are distinct, each from the other because of the following reasons:

Art Unit 1202

Compounds of Groups I and II are structurally dissimilar which are thus separately classified, require separate Chemical Abstract searches and would be expected to raise different issues of patentability - see the art applied below directed to the elected invention. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other remaining members in the Markush group.

Inventions I/II and III/IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the respective products of I and II have more than one distinct use as evidenced by applicants' own disclosure - see p.1 and 2.

Art Unit 1202

During a telephone conversation with Mr. Heaney on 5/2/00 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12, 14-18. Affirmation of this election must be made by applicant in responding to this Office action. Claims 13, 19-22 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Claims 11, 17-18 which link inventions I and II will only be examined with respect to the elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Art Unit 1202

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. In claim 12 what is intended by "benzo-5-yl"?

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide descriptive support (antecedent basis) for the invention claimed.

The examiner cannot find a description of species (e) in claim 2 in the specification.

Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Art Unit 1202

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-12, 14-15, 17-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Perregaard. Boettcher having issued more than a year earlier than the instant filing date teaches similar compounds to that claimed herein and for the same disclosed uses as herein. See formula I compounds in column 1 and exemplified compounds in cols. 11-17. The compounds differ in only one respect to that claimed herein - benzodioxanyl substitution vs. instant R¹ as dihydro benzofuranyl, chromanyl.

Art Unit 1202

Perregaard teaches the interchangeability of the above mentioned rings on similar compounds and for the same uses (as 5HT agonists, antagonists). See definition of Y and Z in col. 1 in the Ar definition. Thus it would have been obvious to one skilled in the art at the time the invention was made to replace the benzodioxane ring system with those taught in Perregaard and thus obtain the instant compounds in view of the equivalency teaching outlined above.

Claims 1-12, 14-15, 17-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,242,925 in view of Perregaard.

While the conflicting claims are not identical, they are not patentably distinct for the same reasons discussed in the above 103 rejection.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Art Unit 1202

Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Said claim would be allowed as the R¹ moiety recited ~~herein~~^{therein} is not taught ~~a~~^{or} suggested by the art of record or from or search in the pertinent art area.

Claims 1-11, 17-18 are rejected under judicial doctrine as being drawn to an improper Markush group. The Markush at Z embraces ~~were~~^{more} than one ~~insertion~~^{invention} as discussed in the above restriction requirement. Note if nonelected subject matter is deleted claim 9 would be an improper dependent. Claim and "Z is N" in claims 12, 14-16 would be superfluous.

Any inquiry concerning this communication should be directed to Examiner Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine is (703) 308-4556 or 305-3592.

BERNHARDT:tcj
March 22, 1995

F Bernhardt
EMILY BERNHARDT
PRIMARY EXAMINER
GROUP 120